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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,497	02/09/2001	Kazuya Nishino	1095.1158/JDH	5669

21171 7590 12/01/2004  
STAAS & HALSEY LLP  
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1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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WASYLCHAK, STEVEN R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/779,497

Applicant(s)

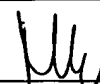
NISHINO, KAZUYA

Examiner

Steven R. Wasylchak

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This office action is in response to Applicant's action received March 26, 2004.
2. Examiner has reviewed Applicant's arguments and has found them to be persuasive; new art rejections are presented.
3. Examiner has corrected his error, an informality, in the patent number used as the prior art. The prior art of record is corrected as being Ahmad (US 5,925,127) instead of Ahmad (US 6,208,974). Accordingly, the period for reply is reset.

### Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahmad (US 5,925,127).

Claim I,

An accounting method for imposing, by a server, a charge for using an application program installed on a client, the method comprising:

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-a function performance detecting step for detecting that a predetermined function of an application program installed on the client was performed;/

abstract; col 1, L60-65; col 2, L63-65; col 11, L 1-22

-a user specifying step for specifying a user who performed the predetermined function; and/ col 2, L26-50

-an accounting step for imposing charges on a user specified by the user specifying step according to the frequency of performance detected by the function performance detecting step./ abstract("...rented on a pay-per-use basis.")

Claim 2,

The accounting method according to claim 1, wherein the predetermined function is to output data from the client to an external device./ abstract: Software Monitor module; col 2, L4-9

Claim 3,

The accounting method according to claim 1, further comprising an application program type specifying step for specifying the type of the application program, wherein the accounting step imposes a charge according to the type of the application program specified by the application program type specifying step./ abstract("...pay-per-use basis."); col 3, L1-5; col 5, L16-31

Claim 4,

The accounting method according to claim 1, further comprising a user registration step for performing user registration in the case of the predetermined function having been performed for the first time./col 24, L 24-33

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Claim 5,

The accounting method according to claim 1, further comprising an imposed charge amount informing step for informing a client which made a request about the amount of charges imposed at that time./ col 2, L5-20; col 8, L 46-54; col 12, L 54-60

Claim 6,

A server for imposing a charge for using an application program installed on a client, the server comprising:

- function performance detecting means for detecting that a predetermined function of a program installed on the client was performed;/ col 1, L55-65; col 2, L4-9; col 8, L54-64; col 9, L1-15

- user specifying means for specifying a user who performed the predetermined function; and / col 2, L20-61

- accounting means for imposing charges on a user specified by the user specifying means according to the frequency of performance detected by the function performance detecting means./ Software Monitor module; col 2, L4-9;

Claim 7,

The accounting method according to claim 1, further comprising a charge deducting step for deducting automatically charges imposed by the accounting step from an account being under the user's name./ abstract (...pay-per-use."); col 3, L5-19

Claim 8,

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An accounting method for imposing, by a server, a charge for using an application program installed on a client, the method comprising:

- a function performance detecting step for detecting that a predetermined function of an application program installed on the client was performed;/ col 1, L46-65; col 3, L1-19

- a user specifying information obtaining step for obtaining information for specifying a user in the case of the performance of the predetermined function having been detected by the function performance detecting step; and/ col 2, L11-61; col 12, L 54-67

- a user specifying information sending step for sending the server the information for specifying a user obtained by the user specifying information obtaining step./ col 2, L11-61; col 4, L38-57

Claim 9,

A client for having a server impose a charge for using an application program installed on a client, the client comprising:

- function performance detecting means for detecting that a predetermined function of a program installed on the client was performed;/ col 1, L46-65; col 2, L11-25; col 3, L1-18

- user specifying information obtaining means for obtaining information for specifying a user in the case of the performance of the predetermined function having been detected by the function performance detecting means; and/ col 2, L11-61; col 12, L 54-67

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-user specifying information sending means for sending the server the information for specifying a user obtained by the user specifying information obtaining means./ col 2, L11-61; col 4,L 38-57

Claim 10. (NEW),

A software usage charging system, comprising:

-a programmed client computer executing software and detecting the software function usage by a user; and/ col 1, L46-65; col 2,L11-25; col 3,L1-18

-a programmed server computer in communication with the client computer and charging the user according to use of the software function in response to the detecting by the programmed client computer./ abstract("...pay- per- use basis."); fig 2 (all); col 3, L1-5; col 5, L16-31; col 7, L1-17; col 8, L41-67


This action is NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R.

Wasylichak whose telephone number is (703) 308-2848. The examiner can normally be reached on Monday-Thursday from 7:00 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065. The fax number for Art Unit 3624 is (703) – 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steven Wasylichak 11/23/04



**JAGDISH N. PATEL**  
**PRIMARY EXAMINER**